

Attorney's Docket No.: 10559-895001/P17799

REMARKS

All pending claims have been canceled. New claims 20-36 have been added. Claim 20 is in independent form. In dealing with placement of a pellicle, claim 20 is not anticipated by U.S. Patent No. 5,880,204 to McCarthy et al. (hereinafter "McCarthy"). In this regard, McCarthy envisaged the use of his coalescable aqueous fluoropolymer dispersions in applications such as high temperature thermoplastic coatings, polishes, room temperature formable paints and coatings, extrudable or injection moldable resins, and adhesives. See McCarthy, col. 1, line 13-18. Since none of these applications involve the placement of a pellicle, new claim 20 is not anticipated by McCarthy.

In the Office action mailed August 14, 2006, the specification was objected to as being informal in usage of the trademark "CYTOP." In particular, the objection contends that CYTOP should be capitalized wherever it appears and be accompanied by generic terminology.

Upon review of the specification, Applicant is unable to locate any usage of "CYTOP" that is not capitalized. Also, paragraphs [0007] and [0019] have been amended to ensure that the trademark "KYNAR" is capitalized. Accordingly, the proprietary nature of trademarks is respected in the

Attorney's Docket No.: 10559-895001/P17799

specification and applicant traverses this portion of the objection.

As for generic terminology, para. [0012] of the specification has been amended so that the first appearance of the trademark "CYTOP" in the Detailed Description is accompanied by an indication that CYTOP is "an amorphous, soluble perfluoropolymer," as originally found in para. [0015]. Usage of "CYTOP" elsewhere in the specification is believed to be made clear by the amendments to para. [0012].

Accordingly, Applicant requests that the objection to the specification be withdrawn.

Although the cancellation of claims 1-19 renders the rejections of those claims moot, many of the issues raised in those rejections are applicable to new claims 20-36. To advance prosecution, applicant now addresses these issues.

The first such issue is the use of the term "copolymer," which now appears in new claims 21-27. The previous rejection contended that the claims were directed to an admixture, rather than a copolymer.

Applicant respectfully disagrees. Upon review of former claims 1-19, applicant finds nothing that suggests that the claims were directed to an admixture rather than a copolymer. If such a suggestion exists, Applicant respectfully requests

Attorney's Docket No.: 10559-895001/P17799

that the Examiner call the suggestion to applicant's attention so that Applicant can address the Examiner's concerns.

Moreover, the specification makes it clear that at least some implementations of the technology involve copolymers. For example, attention is respectfully directed to, e.g., paras. [0022]-[0024] that describe two different monomer units polymerized together.

Accordingly, applicant submits that the recitation of the term "copolymer" in the claims is appropriate.

The second such issue is the recitation of the term "cyclic fluorocarbon oxygen-containing polymer," which now appears in new claims 24 and 27. In particular, the office action contends that this term embraces vast numbers of polymers and that any identification of which particular polymers are appropriate for use would require such undue experimentation that a rejection under 35 U.S.C. § 112, first paragraph is warranted.

Applicant respectfully disagrees. To begin with, Applicant notes that the breadth of claims is only one of several factors that must be considered in making a patentability determination under 35 U.S.C. § 112, first paragraph. See *M.P.E.P* § 2164(a). Since "[i]t is improper to conclude that a disclosure is not enabling based on an analysis of only one of [these] factors while ignoring one or more of the others," and only a single

Attorney's Docket No.: 10559-895001/P17799

factor has been considered, the prior rejection under 35 U.S.C. § 112, first paragraph is facially deficient.

Further, it is well established that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. See, e.g., *M.P.E.P.* § 2164.01 (citing *In re Angstadt*, 537 F.2d 498, 504, 1 (C.C.P.A. 1976)). Since there has been no finding regarding the level of ordinary skill in the art and the type of experimentation typically performed in the art, any assertion that any necessary experimentation is undue is unsupported.

Accordingly, applicant submits that the recitation of the term "cyclic fluorocarbon oxygen-containing polymer" in the claims is appropriate.

The third such issue is the use of the term "surface modified," which now appears in new claim 29. The previous rejection contended that since copolymers are not, *per se*, surface-modified, the term was vague and confusing.

Applicant respectfully disagrees. Nothing in the former claims required that all copolymers be surface-modified. Indeed, the term appeared in dependent claim 19, making it clear that parent claim 16 encompassed copolymers that were not surface-modified. The same is true for the present claims.

Attorney's Docket No.: 10559-895001/P17799

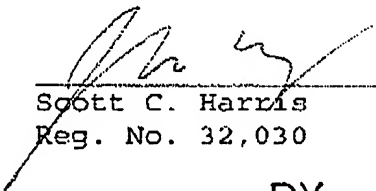
Moreover, the specification makes it clear that some implementations of the technology involve surface-modified copolymers. For example, attention is respectfully directed to para. [0030] which describes various surface modification techniques.

Accordingly, applicant submits that the recitation of the term "surface modified" in the claims is appropriate.

Applicant asks that all claims be allowed. No fees are believed due at this time. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: August 14, 2006

  
\_\_\_\_\_  
Scott C. Harris  
Reg. No. 32,030

Fish & Richardson P.C.  
PTO Customer No. 20985  
12390 El Camino Real  
San Diego, California 92130  
(858) 678-5070 telephone  
(858) 678-5099 facsimile

BY  
JOHN F. CONROY  
REG. NO. 45,485

SCU/JFC/jhg  
10652181.doc